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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/383,560 08/26/99 RUSIN

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EXAMINER

QM12/0622

ARLENE L HORNILLA  
OFFICE OF INTELLECTUAL PROPERTY COUNSEL  
3M INNOVATIVE PROPERTIES COMPANY  
P O BOX 33427  
ST PAUL MN 55133-3427

LEWIS, R  
ART UNIT

PAPER NUMBER

3732  
DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/383,560

Applicant(s)

Rusin et al

Examiner

Ralph Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) *Approved*
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 3732

### **Inconsistency in Claim Numbering**

The originally filed claims lack a claim numbered "30". Consecutive claim numbering is required. Accordingly, originally numbered claims 31-52 have been renumbered 30-51 consecutively.

### **Rejections based on 35 U.S.C. 112, first paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 13, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for blank materials having flexural strengths greater than 350 MPa. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. More particularly, the disclosed and tested samples as reported in Table 2, page 15 have a maximum flexural strength of 342 MPa - there is no basis for supporting the greater than 350 MPa and greater than 500 MPa claims. .

Art Unit: 3732

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19, 36 and 49 are rejected under 35 U.S.C. 102(a) as being anticipated by CTTA, GEL, VMT9A, ZrO<sub>2</sub>, A1X and NORTON as disclosed by applicant in the specification.

Applicant's specification indicates at page 13 that manufacturers other than applicant made the ceramic materials used in the examples. Applicant further indicates that "wafers" of the ceramic materials were cut off of the manufacturer supplied materials. Applicant further states at page 9, lines 22 and 23 that "[t]he dental mill blanks of the present invention may be made in any desired shape or size." The manufacturer supplied materials inherently come in some shape or size which meets applicant's own "any desired shape or size" definition of a "dental mill blank." In Table 3 applicant, specifically indicates CTTA and GEL were the manufacturers of dental mill blanks. The examiner is at a loss as to why applicants are claiming what appears to be admitted prior art as their invention

In regard to claim 36, the content of printed matter provided with the material is of no patentable weight.

Art Unit: 3732

Claims 1, 3-7, 9-19 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Coble (3,026,210).

Coble discloses transparent ceramic aluminum oxide. Applicant indicates at page 9, lines 22 and 23 that “[t]he dental mill blanks of the present invention may be made in any desired shape or size.”

Claims 1, 3-6, 8-19 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhodes et al (4,174,973).

Rhodes et al disclose transparent yttrium oxide materials of “any desired shape” column 2, line 38. Applicant indicates at page 9, lines 22 and 23 that “[t]he dental mill blanks of the present invention may be made in any desired shape or size.”

Claims 1, 2, 4-25, 29-31, 33-41, 43--48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (4,639,218).

Jones et al discloses a single crystal ceramic blank that is milled a desired shape for attachment to a patient's teeth with composite cements. The bracket shape meets the vague “desired shape” limitation of claims 20 and 33.

Art Unit: 3732

Claims 1, 3-7, 9-25, 29-40, and 42-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Oden et al (5,217,375).

Note particularly column 5, lines 5-48.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-28, 30-32, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oden et al (5,217,375).

In regard to claims 26-28, forming the Oden et al ceramic body to its final shape in a timely manner would have been obvious to the ordinarily skilled artisan. In regard to claims 30-32, using conventional methods to accomplish the grinding and milling referred to by Oden would have been obvious to the ordinarily skilled artisan. In regard to claims 36-39, providing instructions and adhesives and lubricants in a "kit" for forming the Oden et al ceramic dental prosthesis would have been obvious to one of ordinary skill in the art.

Art Unit: 3732

**Request for Information**

Applicant's specification indicates that the materials used in the examples were provided by other manufacturers. The examiner requests information and clarification as to whether each of the materials described in the examples as being provided by other manufacturers is (1) admitted prior art, (2) commercially available at the time of the filing of the present application, (3) the sizes and shapes in which it is/was provided, and (4) the uses suggested by the manufacturers for their materials (particularly with regard to being cut, machined, milled or otherwise shaped).


**Prior Art**

Applicant's information disclosure statement of December 14, 1999 has been considered and an initialed copy enclosed herewith

Kelly et al (4,954,080), Forbes Jones et al (5,066,225), Tyszblat (5,447,967), Thiel et al (5,910,273) and Hofmann et al (5,916,498) are made of record.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 305-3590.

R.Lewis  
June 21, 2001

  
Ralph A. Lewis  
Primary Examiner  
Au3732

